



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/585,146

06/30/2006

Kei Watanabe

1WI-16714

9933

7609 7590 08/30/2010
RANKIN, HILL & CLARK LLP
23755 Lorain Road - Suite 200
North Olmsted, OH 44070-2224

EXAMINER

OGDEN JR, NECHOLUS

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

08/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/585,146	Applicant(s) WATANABE ET AL.	
	Examiner Necholus Ogden, Jr.	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,14 and 15 is/are rejected.
- 7) ☒ Claim(s) 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Claim 8 objected to because of the following informalities is withdrawn.
2. Claims 1, 3-10 and 14-15 are rejected under 35 U.S.C. 103(a) as obvious over EP (1488775).

EP '775 disclose a clear liquid skin cleansing formulation comprising at least one nonionic surfactant; a second nonionic surfactant other than the first; a liquid oil ingredient and up to 12% by weight of water (abstract). EP '775 disclose that said nonionic surfactants include POE fatty acid esters and/or ethers such as POE (8) glyceryl monoisostearate (page 3, lines 24-36); liquid oils such as liquid paraffin and silicone oils (0021); and further said compositions include higher fatty acids and higher fatty alcohols having an IOB of 0.6 or lower (0026-0030). See Tables 1-6.

EP '775 is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients within the claimed proportions for the same utility.

3. Applicant's arguments filed 6-17-2010 have been fully considered but they are not persuasive.

Applicant argues and declares in his Declaration submitted on March 17, 2010, that EP '775, when mixed with water in a ratio of 4:6 exhibits a white turbid appearance that turbid and a two phase system being oil phase and micellar aqueous solution wherein both characteristics are in contrast to the present application that states a clear solution and a micellar aqueous solution or a bicontinuous microemulsion phase.

The examiner respectfully contends that first, applicant's claims do not require an appearance limitation such as clarity. Specifically, there is no mention of a clear solution in any of the amended claims and therefore the prior art of record, is not bound as such. Secondly, applicant's conditions 1 and 2 and that the composition comprises less than 5% water and that said solution forms a micellar aqueous solution or a bicontinuous microemulsion phase when mixed with water at a ratio of 4:6. Nothing in these conditions precludes the prior art from forming additional phases as declared by applicant. Applicant states in his declaration at Table 1 that a micellar aqueous solution and an oil phase was formed in EP '775, however, the claims do not preclude additional phases from forming nor has applicant provided any deleterious effect to the contrary. It appears that the 2 condition was met by EP '775 when a micellar aqueous solution was formed as declared by applicant.

With respect to the Declaration, it is noted that applicant chose to run examples 5-8 of Table I of EP '775 to support his argument, however, it is the examiners opinion that additional test should have been run from other examples of EP '775 which comprise various fatty acid esters, and oils. Accordingly, it is determined that criticality has not been met.

To establish unexpected results over a claimed range, applicants should compare a sufficient number of tests both inside and outside the claimed range to show the criticality of the claimed range. In re Hill, 284 F.2d 955, 128 USPQ 197 (CCPA 1960).

An obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not. See KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 WL 1237837, at *12 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Applicant further argues that EP '775 fails to suggest that his compositions are free of white turbidity.

The examiner contends that the most comprehensive claim does not require that the compositions are free of white turbidity.

Applicant argues that the criteria for forming a micellar aqueous solution or a bicontinuous microemulsion phase is not suggested by the compositions of EP '775 and specifically the working examples therein and therefor teaching away from the claimed invention.

The examiner contends that the compositions of EP '775 not exemplified or non-preferred embodiments are considered obvious and one skilled in the art in absence of a showing to the contrary would have been motivated to combine the components to exhibit the claimed composition.

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v.*

Art Unit: 1796

Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989).

Allowable Subject Matter

4. Claim 16 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Necholus Ogden, Jr. whose telephone number is 571-272-1322. The examiner can normally be reached on M-Thu.

Art Unit: 1796

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Necholus Ogden, Jr./
Primary Examiner
Art Unit 1796

no